

REMARKS/ARGUMENTS

Applicant has reviewed and considered the Final Office Action mailed on November 23, 2005, and the references cited therewith.

No claims were amended, added, or cancelled. Claims 1-2, 4-30, and 41-49 are pending in this application.

Power of Attorney

Applicant respectfully requests that the Customer Number and Correspondence Address be updated for this application. A copy is enclosed of the Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address (form PTO/SB/82) and Statement Under 37 CFR 3.73(b) submitted for this application on April 15, 2005.

§ 102 Rejection of the Claims

Claims 1-2, 4-7, 20-25, 43 and 47 were rejected under 35 USC § 102(e) as being anticipated by U.S. Patent No., 6,364,823 to Garibaldi et al. (Garibaldi). Applicant does not admit that Garibaldi is indeed prior art and reserves the right to swear behind the same at a later date.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. In addition, the disclosure must teach the identical invention in as complete detail as is contained in the claim, and must teach each and every claim element arranged as in the claim.

Claim 1

Applicant notes that the Examiner has repeated the arguments used in rejecting claims 1-2, 4-7, 43, and 47 in the Office Action dated November 23, 2005. In response, Applicant respectfully repeats their arguments presented in response thereto. As discussed in Applicant's response of May 16, 2005, Garibaldi first discusses an apparatus ("the patch"), and then separately discusses a material ("the embolic material"). Garibaldi does not teach that the magnetic material with the

sufficiently high Curie temperature used in "the embolic material" is or could be used with "the patch 120." As required, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir.1990).

While Garibaldi does discuss elements recited in claim 1, Garibaldi does not arrange them as provided in claim 1. For example, Applicant is unable to locate in Garibaldi any description of a stent formed with a magnetically susceptible material having a magnetic susceptibility that decreases within a preselected temperature range, as recited in claim 1. Garibaldi does recite a "magnetic patch 120" having a "hoop 122 [that] causes the patch 120 to open to its normal (preferably round) shape" and that "[t]he patch 120 includes magnetic material, for example particles of a magnetically responsive material . . . [that] may be a permeable magnetic material or it may be a permanent magnetic material" (col. 7, line 64 – col. 8, line 11). Garibaldi does not, however, teach that the magnetic material is a magnetically susceptible material that has a magnetic susceptibility that decreases within a preselected temperature range, as recited in claim 1.

Garibaldi provides "an embolic agent . . . [that] is a flowable magnetic material that can be delivered through a microcatheter, but which hardens to form a solid embolic" (col. 11, lines 19-21). Garibaldi indicates that the "magnetic material in the embolic" can have "a sufficiently high Curie temperature" such that when the tissue surrounding an aneurysm is sub-cooled to a temperature below the magnetic material Curie temperature the magnetic material in the embolic is susceptible to the magnetic field, but when the tissue was allowed to warm up to body temperature the magnetic material would lose its magnetic properties. The Examiner, however, appears to suggest that this "flowable magnetic material" could be used for the "magnetic material" of the "patch 120." This, however, is not an accurate interpretation of Garibaldi. Simply put, Garibaldi does not teach that the "flowable magnetic material" could be, or should be, used with the "patch 120." So, Garibaldi

does not teach the identical invention in as complete detail as is contained in claim 1, nor does Garibaldi teach each and every claim element arranged as in claim 1.

In addition, simply asserting that Garibaldi does arrange the elements are recited in claim 1 would not be reasonable to one skilled in the art. For example, as provided by Garibaldi, "[i]n the preferred embodiment, the patch 120 includes a hoop 122 of nitinol . . . that causes the patch 120 to open to its normal . . . shape" (col. 8, lines 2-7). Garibaldi also indicates that "other structure or construction can be provided to cause the patch to assume its extended configuration," but Garibaldi does not teach that any other material besides nitinol can be used to form the "hoop 122" (i.e., structure is defined as something made up of a number of parts that are held or put together in a particular way, and construction is defined as the way in which something is built or put together [The American Heritage® Dictionary of the English Language, Fourth Edition Copyright © 2000]). So the "hoop 122" is only made of nitinol.

As one skilled in the art understands, nitinol is a metal that remembers its geometry. After it is deformed, it regains its original geometry by itself during heating or, at higher ambient temperatures, during unloading. Garibaldi indicates that the tissue surrounding the magnetic material having the sufficiently high Curie temperature needs to be sub-cooled so that the material can be highly susceptible to a magnetic field. However, sub-cooling the tissue in the area of the "patch 120" with this magnetic material runs counter to allowing the nitinol of "the hoop 122" to obtain its predetermined shape. For example, once the patch 120 having this magnetic material was moved under the influence of the magnetic field, the patch 120 would then be warmed to allow the nitinol "hoop 122" to expand to its preconfigured shape. Upon warming, however, the nitinol of "the hoop 122" could move the patch 120 in unpredictable ways relative its location within the body, negating any potential benefit of having used the magnetic material having the sufficiently high Curie temperature. This provides at least one reasonable explanation as to why both Garibaldi did not arrange the elements are recited in claim 1 and why one skilled in the art would not now arrange the elements recited in Garibaldi to provide the invention recited in claim 1.

Applicant further traverses the assertions made in the Examiner's response to Applicant's argument as follows.

The Office Action states that Garibaldi discloses using embolic patches 120 as a stent to support a blood vessel, which patches have a magnetic susceptibility that decreases within a preselected temperature range and a magnetic material whose Curie point below normal body temperature can be used to make patches 120 to form a stent. Applicant respectfully traverses this assertion. As discussed above, Garibaldi does not arrange the elements as provided in claim 1. In addition, one skilled in the art reviewing Garibaldi would clearly understand that the use of the magnetic particles for the "embolic material" in the "patch 120" would conflict with the expressly stated function of the nitinol "hoop 122," as discussed above. If Garibaldi had intended to include the use of magnetic particles for the "embolic material" in the "patch 120" these problems would have been addressed in the patent.

Applicant respectfully requests reconsideration and withdrawal of the 102 rejection for independent claim 1, as well as the claims which depend therefrom.

Claim 20

Applicant notes that the Examiner has repeated the arguments used in rejecting claims 20-25 in the Office Action dated November 23, 2005. In response, Applicant respectfully repeats their arguments presented in response thereto and expands upon them as follows.

Applicant's independent claim 20 recites a "vascular treatment system" that includes "a medical device . . . [that includes] a magnetically susceptible material . . . having a Curie temperature in a preselected temperature range, such that the implantable device heats to a temperature sufficient to treat the treatment site when the electromagnetic field is applied." In contrast, Garibaldi provides "an embolic agent" having a "magnetic material" that is susceptible to a magnetic field when cooled to a temperature below the Curie temperature of the magnetic material. By lowering the body temperature of the patient, the embolic material can be magnetically controllable so as to allow the aneurysm to be filled and

polymerization to occur. However, Garibaldi provides that when the patient's body temperature is allowed to rise the embolic material does not remain strongly magnetic. Garibaldi appears to teach this procedure so that the embolic agent does not "interfere with subsequent diagnostic and therapeutic procedures" (col. 13, lines 12-13).

Applicant's claim 20 recites, on the other hand, that the "implantable device heats to a temperature sufficient to treat the treatment site when the electromagnetic field is applied." Applicant's claim differs in that although Garibaldi does teach that as body temperature rises the magnetic property of the embolic agent decreases, it does not teach an embolic agent that is itself heated when an electromagnetic field is applied. Also, Garibaldi is allowing body temperature to provide heat so as to decrease the magnetic property of the embolic agent, to limit interference with later diagnostic procedures. The instant claimed invention, however, uses a magnetic field to heat the medical device itself, and the increased temperature of the medical device then treats the treatment site. Also, as recited in claim 20, the Curie temperature in the preselected range is being used to keep the "implantable device . . . to a temperature sufficient to treat the treatment site when the electromagnetic field is applied" while Garibaldi is using a Curie temperature to control the magnetism of embolic agent once it has formed. As such, Garibaldi does not teach all the elements as arranged in nor does Garibaldi teach an embodiment in as complete detail as is contained in the claim 20.

Applicant respectfully requests reconsideration and withdrawal of the 102 rejection for independent claim 20, as well as the claims which depend therefrom.

§ 103 Rejection of the Claims

Claims 8, 11-12, 26, 28-29, were rejected under 35 USC § 103(a) as being unpatentable over Garibaldi. Applicant respectfully traverses the rejection as follows.

As discussed above for the 102 rejections, Garibaldi does not support a proper 102 rejection of independent claims 1 and 20. As claims 8, 11, and 12 are dependent claims of independent claim 1, and claims 26, 28, and 29 are dependent

claims of independent claim 20, the 103 rejection of claims 8, 11, 12, 26, 28, and 29 should be withdrawn.

Reconsideration and withdrawal of the 103 rejection for claims 8, 11, 12, 26, 28, and 29 are respectfully requested.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 236-0122 to facilitate prosecution of this matter.

CERTIFICATE UNDER 37 CFR §1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS AF Commissioner for Patents, P.O. BOX 1450 Alexandria, VA 22313-1450, on this 4th day of January, 2006.

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